



## Patent

Attorney's Docket No. 027575-039

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Patent Application of**

**Gregory S. MENDOLIA**

**Application No.: 08/880,648**

**Filed: June 23, 1997**

**For: ACOUSTIC PIPE FOR FLIP STYLE  
CELLULAR TELEPHONE**

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)  
) **Group Art Unit: 2744**  
)  
) **Examiner: C. Craver**  
)  
) **Appeal No.**

**REPLY BRIEF**

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## **I. INTRODUCTION**

This Reply Brief is submitted in response to the Examiner's Answer.

## **II. RESPONSE TO EXAMINER'S ANSWER**

The comments and arguments contained in the Examiner's Answer necessitate the discussion and explanation contained in this Reply Brief.

### **A. The Examiner Concedes That the Claimed Invention is Not Disclosed in Either *Rabe* or *Thorton***

In the Examiner's Answer, the Examiner concedes that *Rabe* does not "expressly disclose that the acoustic channel extends entirely along one of the peripheral edges of the flip". See bottom of page 3 of the Examiner's Answer. The Examiner next refers to *Thorton*, acknowledging that "the cavity of *Thorton* does not extend completely along the edge of the flip". See page 4, lines 5-6. Thus, the Examiner concedes that neither reference relied upon discloses the claimed feature of "an acoustic channel extends entirely along one of the peripheral edges of the flip", as defined in independent Claims 1 and 10.

In rejecting claims under § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). In order to establish a *prima facie* case of obviousness, the prior art teachings must be sufficient to suggest to one having ordinary skill in the art to make the modification needed to arrive at the claimed invention. *In re Lalu*, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). The Examiner seeks to overcome these differences by stating that it would have been a routine engineering decision, without providing any evidence as to why this might be the case. However, the subjective opinion of the Examiner, without evidence in support thereof, does not provide a factual basis upon which the legal conclusion of obviousness may be reached. *In re GPAC, Inc.*, 35 U.S.P.Q.2d 1116, 1123

(Fed. Cir. 1995). Neither *Rabe* nor *Thorton* provide the factual basis necessary to support the Examiner's conclusion of obviousness.

**B. Criticality is Not a Requirement for Patentability**

The Examiner seeks to make criticality a requirement for patentability. However, it is well established that criticality is not a requirement for patentability. *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Accordingly, the Examiner has failed to prove a *prima facie* case of obviousness.

**II. CONCLUSION**

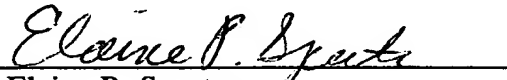
For at least the reasons set forth above, it is respectfully submitted that the rejection of Claims 1-13 is improper and should be reversed.

Respectfully submitted,

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Date: March 23, 2001

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